

REMARKS

Upon entry of the present amendment, claims 12-13, 16 and 18-25 will remain pending in the above identified application and stand ready for further action on the merits. The amendments made herein to the claims do not incorporate new matter into the application as originally filed, as evidenced by the following facts.

- * Claims 12-13 and 16 have simply been amended to an independent format by reciting elements previously recited in claim 4 or 5 (now cancelled). Claim 13 has also been revised to more particularly recite *"wherein prior to or during applying the polishing composition to the magnetic disk substrate or the polishing pad, the polishing composition is in contact with a member that is made of a metal coated with a resin or that is made of a resin"*, which finds support at page 14, line 25 to 15, line 12 of the specification.
- * Newly added claims 18-20, which each depend from claim 12, simply incorporate subject matter from prior claims 10, 11 and 3, respectively (each now cancelled).
- * Newly added claim 21, which depends from claim 13, simply incorporates subject matter from prior claim 10 (now cancelled).

* Newly added claims 22-25, which each depend from claim 16, simply incorporate subject matter from prior claims 14, 15, 17 and 3, respectively (each now cancelled). Claim 24 (like claim 13) also contains recitations finding support at page 14, line 25 to page 15, line 12 of the specification.

It is additionally noted that the instant amendment of the claims is fully acceptable under the provisions of 35 USC § 1.116, as it simplifies issues outstanding for purposes of appeal and/or otherwise puts the claims into better condition for allowance, while at the same time not presenting substantial new issues for the Examiner's consideration. Accordingly, entry of the instant amendment to the claims is respectfully requested at present.

Interview With Examiner

The Applicant's appreciate the Examiner's courtesy in granting an interview with the undersigned on March 3, 2005. Comments set forth in the Examiner Interview Summary of the interview correctly set forth a summary of discussions held during the interview, and the Examiner's position at the end of the interview.

Claim 13 has been amended herein to recite a pH parameter as suggested by the Examiner in the Examiner Interview Summary Form (PTOL-413).

Claim Rejections - 35 USC § 112

Claims 13 and 17 have been rejected under the provisions of 35 USC § 112, second paragraph. Reconsideration and withdraw of this rejection is respectfully requested based on the following considerations.

Claim 17 is no longer pending. In claim 13 (and newly added claim 24), it is recited:

"wherein prior to or during applying the polishing composition to the magnetic disk substrate or the polishing pad, the polishing composition is in contact with a member that is made of a metal coated with a resin or that is made of a resin."

It is submitted that the above language is fully acceptable under the provisions of 35 USC § 112, second paragraph, as it particularly and distinctly sets forth the inventive discovery that the applicant's regard as their own, and at the same time is not indefinite or otherwise unacceptable under 35 USC § 112.

Claim Rejections - 35 USC § 102/103

Claims 1-3 and 7-9 have been rejected under 35 USC § 102(b) as anticipated by or, in the alternative, under 35 USC § 103(a) as obvious over *Ina et al.* '075 (US 6,355,075). Claims 1, 3 and 8 have been rejected under 35 USC § 102(b) as anticipated by or, in the alternative, under 35 USC § 103(a) as obvious over *Loncki et al.* '848 (US 5,860,848). Claims 2 and 7 have been rejected under 35 USC

§ 103(a) as obvious over *Loncki et al.* '848. Claims 1, 3-6, 8, 11 and 15 have been rejected under 35 USC § 102(a or e) as anticipated by or, in the alternative, under 35 USC § 103(a) as obvious over *Ohno et al.* '815 (US 2003/0084815 A1). Claims 2, 7, 10, 13, 14, and 17 have been rejected under 35 USC § 103(a) as obvious over *Ohno et al.* '815. Claims 1-17 have been rejected under 35 USC § 103(a) as obvious over *GB 2,354,524*. Reconsideration and withdraw of each of these rejections is respectfully requested based on the amendments and remarks presented herein, as well as the following considerations.

Rejection over Ina et al. (US 6,355,075)

It is submitted that the rejections based on Ina et al. '075 must be withdrawn, as the rejected claims have been cancelled. Notably the Ina et al. reference was not applied against any of prior claims 12, 13 and 16, which are now written in an independent format.

Rejections over Loncki et al. (US 5,860,848)

It is submitted that the outstanding rejections based on Loncki et al. '848 must be withdrawn, as the rejected claims have been cancelled. Notably the Loncki et al. reference was not applied

against any of prior claims 12, 13 and 16, which are now written in an independent format.

Rejections over Ohno et al. (US 2003/0084815 A1)

First, it is noted that claim 17 has been cancelled, and claim 13 has been amended to recite a pH range found in claim 12. Since claim 12 was not rejected over Ohno et al., it is submitted that claim 13 is also patentable over the same Ohno et al. reference.

Second, in the office action at page 4, lines 17-19, the Examiner asserts that:

"The limitations of new claims 13 and 17 are obvious because these limitations are an obvious modification therefore because this will avoid the introduction of unwanted impurities to the slurry."

At [0038] in Ohno et al., however, the relationship between impurities and storage stability of the polishing composition is referred to, and the concentration of impurities in the polishing composition is focused on therein.

As such, it is clear from the Ohno et al. disclosure that no motivation exists or occurs in Ohno et al. for selecting a member [e.g., a tank, a pipe or a pump] that is otherwise extraneous to the polishing composition, and as recited in claim 13 (or claim 24) is one "that is made of a metal coated with a resin or that is made of a resin."

Specifically, Ohno et al. completely fails to teach that impurities that are not derived from polishing composition *per se* may affect surface defects of a substrate. More importantly, if Ohno et al. had any realization that the copper concentration in the polishing composition may affect surface defects of a substrate, it might have been easy for Ohno et al. in its claimed process to select materials without copper elution properties as members coming into contact with the polishing composition. However, because Ohno et al. completely failed to appreciate or teach the harmful influence of copper on surface defects, it follows that the present invention is in no way rendered obvious by the disclosure of Ohno et al. For example, Ohno et al. never teaches, envisions or discloses that members to be contacted with the polishing composition should be made of a metal coated with a resin or made of a resin, as taught in the specification at page 14, line 25 to page 15, line 20, and as recited in instant claims 13 and 24.

Accordingly, it is clear that the cited Ohno et al. reference is completely incapable of either anticipating or rendering obvious any of the instantly pending claims 12-13, 16 or 18-25. Any opposing consideration of the USPTO must be reconsidered.

Rejection over GB 2 354 524

GB 2 354 524 (GB '254) fails to teach a low content of copper. In GB '524, it appears that problems of surface defects are solved by using a phosphate compound as an essential component of a polishing composition (see page 10, lines 3-5, and Table 1 at page 20). Whereas, in the present invention, it does not require to use a phosphate compound. Instead, with the use of a low content of copper in the present invention, excellent effects for reducing surface defects can be exhibited.

In this context, the Examiner's attention is directed to Table 1 of the specification (see page 19), and particularly the data for Examples 1-8 and Comparative Examples 1-4, wherein a clear difference in results is obtained and shown. In Table 1 it is also shown that inventive Examples 1-8 had copper concentrations that were much lower than comparative Examples 1-4. In table 1, evaluation results marked with double circles (⊙), circles (○) and triangles (△) indicate acceptable products, as is described at page 18 of the specification.

Based on the above considerations, it is clear that the instant claims are in no way rendered obvious by the disclosure of GB '524.

CONCLUSION

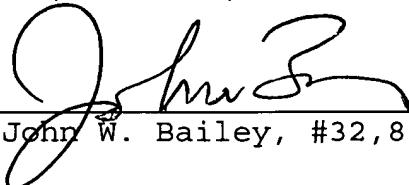
Based upon the amendments and remarks presented herein, the Examiner is respectfully requested to withdraw all outstanding rejections of record and to issue a Notice of Allowance clearly indicating the patentability of each of the pending claims 12-13, 16 and 18-25.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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